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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,588	03/30/2001	S. Sean Moore	UV/192	6830
1473 7590 01/10/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			EXAMINER LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/823,588

Applicant(s)

MOORE ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-18,20-24,26-37,40-43,45-48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-18,20-24,26-37,40-43,45-48 and 50-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3622

### **DETAILED ACTION**

1. Claims 1, 2, 6-18, 20-24, 26-37, 40-43, 45-48 and 50-63 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001.

### **Response to Amendment**

2. In response to Final Rejection filed 06/22/2006, the Applicant filed an RCE on 09/21/2006, which amended claims 1, 6-10, 12-14, 18, 26-28, 32-37, 40-43, 45-48, 52-53, cancel claim 25 and added new claims 54-63.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 35 recites "at least one source address is a telephone number". Nowhere, in Applicant's specification said limitation is recited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3622

applicant regards as the invention. Claims 1 and 37 recite "receiving at the user equipment the plurality of advertisements related to at least one object". Said limitation is indefinite because it seems to recite that a plurality of advertisements are linked to a single object when Applicant's specification teaches that an object is linked to an URL source and said URL source is used to pull or push advertisements located in said source (see Applicant's specification page 12). For purpose of art rejection, said limitation would be interpreted as metadata that contains a source address to download an advertisement from a location, where the advertisement that is presented to a viewer may be the advertisement currently available at the source (see Applicant's specification page 6, lines 22-35).

#### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 3622

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 6-18, 20-24, 26-34, 37, 40-43, 45-48 and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (U.S. 6,357,042).

As per claims 1, 18, 32, 36, 37, 43, 48 and 53-63, Srinivasan teaches:

A method executed by at least one computer processor for providing metadata-selected advertisements, comprising:

receiving *at user equipment* media comprising at least one object (see “CPE” or “set top box”; col 7, lines 35-50; col 12, lines 20-40; col 17, lines 63-67; col 20, lines 45-55; col 22, lines 1-35; col 29, lines 45-65; col 31, lines 1-15), metadata associated with the *at least one* object and containing a description of the *at least one* object, and metadata associated with a plurality of advertisements related to the *at least one* object (see column 5, line 62 – column 6, line 19; column 6, lines 10-18 “advertisements, may for example, be associated with a tracked object”; column 32, lines 22-30);

receiving *at the user equipment* the plurality of advertisements related to the *at least one object* (see col 22, lines 1-10; col 31, lines 1-15; col 33, lines 1-20; col 38, lines 35-50);

displaying the media and the *at least one* object on a viewing device (see column 7, lines 37-49) *at the user equipment* (see col 7, lines 25-50; col 22, lines 1-35; col 30, lines 40-65);

receiving a user selection of *one of* the *at least one* object displayed on the viewing device (see column 7, lines 35-50; col 22, lines 1-10);

Art Unit: 3622

processing metadata associated with the object selected by the user (see col 3, lines 10-20; col 6, lines 10-20; col 12, lines 25-40; col 22, lines 1-10; column 32, line 21 – column 33, line 3). Srinivasan assigns metadata (i.e. URLs) to an entity in a video and the user click said entity in said video and receive advertisements from said clicking.

comparing *at the user equipment* the metadata associated with the object selected by the user with the metadata associated with the plurality of advertisements related to the object (see column 7, lines 25-50; col 12, lines 20-35; col 22, lines 1-10). ; and

selecting *at the user equipment* one of the plurality of advertisements related to the object based on the comparison (see column 7, lines 25-50; col 22, lines 1-10; col 32, lines 20-40)

monitoring the selected advertisement (see column 7, lines 35-49; column 31, line 45-56);

*downloading to the user equipment the plurality of advertisements related to the media* (see col 29, lines 45-65; col 31, lines 1-15; col 33, lines 1-5; col 34, lines 55-65);

monitoring the selected advertisement, collecting data on the selected advertisement (see column 7, lines 36-49), recording the data and downloading the selected advertisement and displaying the selected advertisement (see col 12, lines 20-40; column 22, lines 1-35; col 31, lines 47-64).

As per claim 2, Srinivasan teaches:

The method of claim 1 further comprising displaying the selected advertisement on the viewing device (see column 12, lines 20-35; column 32, lines 21-64).

As per claims 6, 20, 40, 45 and 50, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the *at least one* object and the metadata associated with the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 7, 21, 41, 46 and 51, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the *at least one* object and the metadata associated with the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56; col 37, lines 5-67).

As per claims 8, 22, 42, 47 and 52, Srinivasan teaches:

The method of claim 1 further comprising storing the metadata associated with the *at least one* object and the metadata associated with the plurality of advertisements (see column 17, lines 20-25; col 32, lines 21-31; col 33, lines 1-3).

As per claims 9 and 23, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the *at least one* object and the metadata associated with the plurality of advertisements are stored on a single storage device (see figure 16; column 32, lines 21-31; col 34, line 55 – col 35, line 20).

As per claims 10 and 24, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the *at least one* object and the metadata associated with the plurality of advertisements are stored on a plurality of storage devices (see figure 16, column 30, lines 53-67).

As per claim 11, Srinivasan teaches:

The method of claim 1 further comprising receiving the selected advertisement (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 12 and 26, Srinivasan teaches:

The method of claim 1 wherein the *plurality of* advertisements are received within the media (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 13 and 27, Srinivasan teaches:

The method of claim 1 wherein the *plurality of* advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 14 and 28, Srinivasan teaches:

The method of claim 1 wherein the *plurality of* advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56).

As per claims 15 and 29, Srinivasan teaches:

The method of claim 1 further comprising storing the selected advertisement (see column 32, lines 21-55).

As per claims 16 and 30, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a single storage device (see figure 16, column 32, lines 21-31) .

As per claims 17 and 31, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 33, Srinivasan teaches:



The method of claim 32 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements further contain *at least one* source address (see column 32, lines 21-40).

As per claim 34, Srinivasan teaches:

The method of claim 33 wherein *at least one of the at least one* source address is a Uniform Resource Locator (see column 32, lines 21-40).

Claim 54, Srinivasan teaches:

The method of claim 1 further comprising periodically receiving the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 55, Srinivasan teaches:

The method of claim 1 further comprising receiving the plurality of advertisements from one or more remote locations in response to requests made by the user equipment (see col 32, lines 20-45).

Claim 56, Srinivasan teaches:

The method of claim 1 further comprising polling one or more remote location for the plurality of advertisements (see col 34, lines 10-25).

Claim 57, Srinivasan teaches:

The method of claim 1 further comprising storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 58, Srinivasan teaches:

The method of claim 2 further comprising ordering one or more items displayed by the selected advertisement (see col 32, lines 35-40).

Claim 59, Srinivasan teaches:

The system of claim 37 wherein the at least one receiver periodically receives the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 60, Srinivasan teaches:

The system of claim 37 wherein the at least one receiver receives the plurality of advertisements from one or more remote locations in response to requests made by the processor (see col 32, lines 20-45).

Claim 61, Srinivasan teaches:

The system of claim 37 wherein the processor is configured to poll one or more remote locations for the plurality of advertisements (see col 34, lines 10-25).

Claim 62, Srinivasan teaches:

The system of claim 37 further comprising at least one storage unit for storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 63, Srinivasan teaches:

The system of claim 37 wherein the processor is operative to order one or more items displayed by the selected advertisement (see col 32, lines 32-40).

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

Art Unit: 3622

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (U.S. 6,357,042).

As per claim 35, Srinivasan does not expressly teach:

The method of claim 33 wherein the *at least one of the at least one* source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Srinivasan would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

### **Response to Arguments**

6. Applicant's arguments filed 09/21/2006 have been fully considered but they are not persuasive. The Applicant argues that Applicant's claimed approach for providing metadata-selected advertisements, as defined by amended claim 1 is fundamentally superior to Srinivasan approach for providing personalized advertisement because according to the Applicant, his claimed invention obviate the need to associate each advertisement with a URL, together with the possibly cumbersome task of keeping URLs stored in metadata in sync with the Internet locations of advertisements. Furthermore, Applicant argues that his claimed approach of selecting from a plurality of advertisements received at the user equipment provides several advantages over Srinivasan such for example, advertisements related to user-selected objects may continue to be accessible even during network outages, latency between selecting an

Art Unit: 3622

object and presenting the related advertisement to the user may be substantially reduced and delivery of the plurality of advertisements to the user equipment may be planned to reduce, for example, peak time network traffic. The Examiner answers that Applicant is arguing about limitation not stated in the claims or in the Applicant's specification, as Applicant's specification teaches that an object is linked to an URL source and said URL source is used to pull or push advertisements located in said source (see Applicant's specification page 12). Therefore, contrary to Applicant's argument, Applicant's specification teaches a need to associate each advertisement with a URL. That the advertisement at the URL source address is updated for a new advertisement does not mean that said new advertisement is not linked to said URL source address.

The Applicant further argues that Examiner's contention that Srinivasan selects advertisements based on metadata-embedded description of a selected object is unsupported by Srinivasan. Applicant further argues that although Srinivasan makes references to providing "additional network-stored information about an entity", Srinivasan does not how or suggest anywhere, according to the Applicant, that this information is used to select advertisements when the user selects an entity. The Examiner answers that Srinivasan teaches that "With the technologies described above becoming more available in the market place, it has become desirable to further integrate the technologies described so that a user viewing a video presentation might be enabled to gather additional information about a specific image entity or entities portrayed in a video through interactive method. An ultimate goal is to provide a means

Art Unit: 3622

for advertisers to promote and sell products through user interaction in a way that minimizes steps required by such a user to access additional information regarding traditionally advertised products such as through commercials and the like" (see col 2, lines 20-30). Srinivasan also teaches that "It will be apparent to one with skill in the art that those who advertise and promote products or services may utilize the capability as taught by the present invention to create a venue for the promotion of such products or services. For example, a subscriber (end user) to a service specializing in providing video media wherein interactive advertisements are presented may obtained CPE equipment adapted to display, identify, and provide, through interactive device, methods for obtaining additional information regarding image entities. Such interaction may be a simple mouse click on the entity during playback of the video which may invoke a link to a network-based data-server that may deliver the data to the end user via modem connection or the like" (see col 12, lines 25-40). Therefore, contrary to Applicant's argument, Srinivasan teaches that the additional network-stored information about an entity is used to select advertisements when a user selects the entity, where the inserted metadata in said entity (*i.e.* URL; see col 17, lines 20-25) is used to pull advertisements related to said selected entity.


### Conclusion

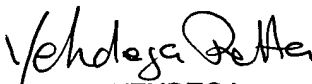
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
June 5, 2006

  
RETTAYEHDEGA  
PRIMARY EXAMINER